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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,951	12/13/2006	Timothy Edward Milverton	207,550	4134
38137 7590 05/15/2008 ABELMAN, FRAYNE & SCHWAB 666 THIRD AVENUE, 10TH FLOOR NEW YORK, NY 10017				
EXAMINER				
HIGGINS, GERARD T				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
05/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,951

Applicant(s)

MILVERTON ET AL.

Examiner

GERARD T. HIGGINS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/13/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 04/24/2006

DETAILED ACTION

Priority

1. Receipt is acknowledged of a certified copy of the Australian Application No. 2003905847 referred to in the oath or declaration or in an application data sheet. If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119(a)-(d), applicant should also file a claim for such priority as required by 35 U.S.C. 119(b). If the application being examined is an original application filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(a)(1)(i). If the application being examined has entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and Regulations of the PCT. See 37 CFR 1.55(a)(1)(ii). Any claim for priority under 35 U.S.C. 119(a)-(d) or (f) or 365(a) or (b) not presented within the time period set forth in 37 CFR 1.55(a)(1) is considered to have been waived. If a claim for foreign priority is presented after the time period set forth in 37 CFR 1.55(a)(1), the claim may be accepted if the claim properly identifies the prior foreign application and is accompanied by a grantable petition to accept an unintentionally delayed claim for priority. See 37 CFR 1.55(c).

Information Disclosure Statement

2. The information disclosure statement filed 04/24/2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: the printable layer **11** is not shown in Figure 1 as stated in the specification at page 3, lines 22-23. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: at page 1, line 19 ".an" is a typographical error. Also is the phrase "in plan" at page 4, lines 12-14 correct?

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants are attempting to claim that the "removable borders are formed on a membrane that incorporates the printable layer;" however, this is indefinite because applicants' specification provides no explanation of what the word incorporate means. They describe situations where the removable borders are placed above or below the printable layer (page 4, lines 16-27), but they fail to include a situation where the tabs are "incorporated" into the printable layer or to what extent that the tabs are "incorporated."

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande (6,403,191) or Rosenbaum et al. (6,514,588) in view of Chen (6,168,841).

With regard to claim 1, Casagrande discloses labels for CD's with a removable outer border adjacent the outer periphery of the printable layer, please see Figs. 3 and

5.

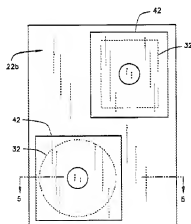


FIG. 3

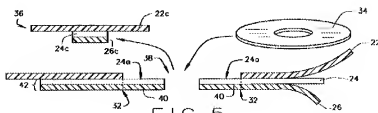
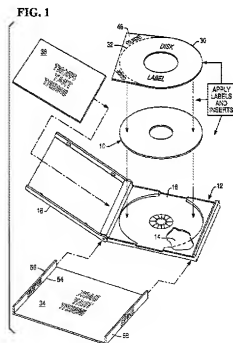


FIG. 5

With regard to the fact that the CD or DVD has a data, reflective, and lacquer/protective layer, the Examiner takes the position that the CD's of Casagrande would intrinsically

have a data, reflective, and lacquer/protection layer. These are all well-known layers in optical recording media; alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the labels of Casagrande on any type of optical recording medium, including those with layers claimed. The label (printable layer) has a removable slug **36** in the center into which a CD can be placed. This device is designed to help align the label and CD such that the CD is balanced and will play properly (col. 6, lines 37-52). After the CD is placed into the well **38** the perforations **32** can be used to remove the outer border adjacent the outer periphery of the printable layer **26** (col. 7, lines 1-7); however, Casagrande does not teach a removable inner border adjacent the inner periphery.

Rosenbaum et al. teach CD labels with an alignment ability as well, please see Fig. 1.



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With regard to the fact that the CD or DVD has a data, reflective, and lacquer/protective layer, the Examiner takes the position that the CD's of Rosenbaum et al. would intrinsically have a data, reflective, and lacquer/protection layer. These are all well-known layers in optical recording media; alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the labels of Rosenbaum et al. on any type of optical recording medium, including those with layers claimed. Rosenbaum et al.'s labels are applied by placing the CD **10** into a conventional jewel case **12** and then applying the label **30** onto the CD using the outer borders **48** as a guide to applying it to the CD (col. 4, lines 11-51). The outer border is then removable along the perforation line **32**; however, Rosenbaum et al. fail to teach a removable inner border adjacent the inner periphery.

Chen teaches a label adapted for use on optical discs, please see Figs. 4 and 7.

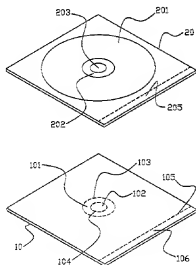


FIG. 4

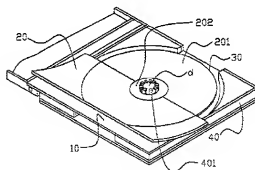


FIG. 7

The label **20** has an inner periphery that is established by removing the portions **102** and **203** to form the hole **d**. The disc is then placed in a casing **40**, which has central securing posts **401** (i.e. a jewel case). The size of the hole **d** is such that it aligns with the securing posts to thereby align the sticker on the CD. Chen goes on to teach that the section **202** (inner border adjacent the inner periphery) can be selectively removed depending on the design of the patterns or words (col. 3, lines 50-55).

Since Chen, Rosenbaum et al., and Casagrande are all drawn to labels for optical recording media, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the removable inner border of Chen into either the device of Casagrande or Rosenbaum et al. The results of which would have been predictable to one having ordinary skill; further, each of the elements would have performed the same in combination as they had separately. The motivation for doing this is to provide a label that has additional alignment mechanisms to assure that a CD label will be centered, and thereby prevent errors during recording or playback.

With regard to claim 2, it has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Merely superimposing 2 or 3 labels over one another would not produce an unexpected result; furthermore, one would have been motivated to do so in order to provide multiple levels of design that were printed in a precise manner.

With regard to claim 3, it is clear that all of the above references are teaching that the label is to be placed on the upper face of the CD, otherwise the CD or DVD could not be played back as the label would be obstructing the view of the laser.

With regard to claims 4, 5, 9, and 10, each of the labels would intrinsically be upon the lacquer layer (upper face); further, since the upper face of the labels comprises the printable layer, this therefore means that the removable border is beneath (before) the printable layer. Additionally, this also means that the removable borders are formed on a membrane beneath the printable layer; however, by examining the above Figures, it is also clear that the borders also incorporate the printable layer.

With regard to claim 11, the removable inner border of Chen is designed for the central hub/hole of the CD, while the removable outer borders of Casagrande and Rosenbaum et al. are designed for the outer border of the CD. This therefore means that they are formed on separate annuli, and since the upper face of the labels comprises the printable layer, this therefore means that the removable borders are beneath (before) the printable layer.

9. Claims 6-8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande (6,403,191) or Rosenbaum et al. (6,514,588) in view of Chen (6,168,841) as applied to claim 2 above, and further in view of Pieper et al. (US 2002/0068141).

Casagrande or Rosenbaum et al. in view of Chen render obvious all of the limitations of applicants' claim 2 in section 8 above; however, they fail to disclose removable tabs for the borders.

With regard to claims 6 and 7, Pieper et al. disclose removable grasping tabs for CD labels [0025]. The grasping tabs are used for simplified handling of the cover material for when it is being pulled off.

Since all of the references are drawn to labels for CD's, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the tabs of Pieper et al. with the devices of Casagrande or Rosenbaum et al. in view of Chen. The results of such a combination would have been predictable to one having ordinary skill; further, each of the components would have performed the same in combination as they had separately. A motivation for using the tabs would have been for the increased ease of handling as outlined by Pieper et al.

Additionally, it would have been obvious to one having ordinary skill to adapt the tabs to provide ease of tearing off the inner and outer borders as that would comprise an increase in ease of handling the label devices; further, placing the tabs on one border or multiple label borders, or placing second tabs on the first tabs for removal of said first tabs is a mere duplication of parts. It has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Placing removable tabs at multiple positions does not constitute a new or

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unexpected result as the tabs still function as removable tabs designed for ease of handling.

With regard to claims 12 and 13, Pieper et al. state that their tabs are perforated for removal after the label is applied [0025].

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other references are included to show the general state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 7:30am-5pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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